REMARKS

Overview of the Office Action

Claims 1 and 2 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,382,970 to Kiefl ("Kiefl") in view of U.S. Patent No. 5,630,203 to Weinblatt ("Weinblatt"), and further in view of U.S. Patent No. 6,463,271 to Schroeder et al. ("Schroeder"). Claims 3 and 4 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kiefl in view of Weinblatt, and further in view of U.S. Patent No. 6,173,158 to Hansen et al. ("Hansen").

Claim Status

Claims 1-4 remain pending.

Summary of subject matter disclosed in the specification

The following descriptive details are based on the specification. They are provided only for the convenience of the Examiner as part of the discussion presented herein, and are not intended to argue limitations, which are unclaimed.

Disclosed is an apparatus for monitoring an audience member tuned to a broadcast program. The apparatus includes a portable audience monitoring unit adapted to be worn by the audience member. The monitoring unit includes means for detecting a code signal that forms the broadcast signal in combination with a programming signal used to perform the program. The code signal corresponds to the broadcast program to which the audience member is tuned.

The word "broadcast" is described on page 11 of the present application as being generated by a signal transmission medium, such as over the airwaves, cable, satellite, etc. In describing the code as being combined with the programming signal to form the broadcast

signal, the claims explicitly require having the code broadcast together with the programming signal by the same transmission medium at the same time.

The portable monitoring unit further includes means for storing the detected code signal. The monitoring unit further includes means for outputting the detected code signal stored in the audience monitoring unit, and communication means for transmitting the outputted detected code signal to a central processing station, wherein the communication means communicates with Cellular Digital Packet Data (CDPD). In another embodiment, the communication meansutilizes a ReFLEX protocol.

Descriptive summary of Kiefl

Kiefl discloses a technique for monitoring and collecting data on, for example, the viewing habits of television viewers. A typical remote control 10 is used for switching among the available channels, and it is relied upon in this monitoring technique to provide a channel identifier signal. The channel identifier signal is stored in memory 28 and eventually transferred by cellular phone module 31 to a central location 30. Thus, the channel identifier signal is not part of the broadcast signal because it is not combined for transmission with the programming signal by the same signal transmission medium.

Personal data meters 16, 17 and 18 are provided to detect the output signal of remote control 10. These data meters are described as being "simply placed adjacent the television receiver 15 so that each may receive any infrared signal 12 emitted by remote control 10." See col. 5, lines 44-47. Thus, the personal data meters are clearly and explicitly described as being not portable.

Descriptive summary of Weinblatt

Weinblatt discloses an audience surveying technique which broadcasts a signal that is a combination of a programming signal and a surveying signal. At the receiver, the surveying signal is separated from the programming signal and a signal related thereto is detected by portable devices worn by audience members to determine the signal source to which each audience member was tuned.

Descriptive summary of Scroeder

Schroeder discloses a wireless voice and data communication system with a portable radio telephone handset that has a CDPD mode.

Descriptive summary of Hansen

Hansen discloses a telecommunications network having a local service node provided with a two-way communicator 300 that includes an RF transceiver 310. The RF transceiver 310 can be a two way pager such as a REFLEX pager.

Claims 1 and 2 are allowable over Kiefl in view of Weinblatt and Schroeder

Salient features of the present claimed invention include the following:

1. The apparatus includes a portable audience monitoring unit adapted to be worn by the audience member.

2. The monitoring unit includes means for detecting a code signal that forms the broadcast signal in combination with a programming signal used to perform the program.

As regards above-listed feature no. 1, the Examiner contends (see the second paragraph on page 3 of the Office Action) that "Kiefl teaches an apparatus ... comprising: a portable audience monitoring unit adapted to be worn by the audience member (Figures 1, 2, Abstract, Col. 5 ;lines 37-41)." This statement by the Examiner, with all due respect, is clearly wrong. As explained above, personal data meters 16, 17 and 18 (which correspond to the claimed "audience monitoring unit") are provided to detect the output signal of remote control 10, and these data meters are described as being "simply placed adjacent the television receiver 15 so that each may receive any infrared signal 12 emitted by remote control 10." See col. 5, lines 44-47. Thus, the personal data meters are clearly and explicitly described as being stationary devices.

Moreover, the Examiner's reliance on Figures 1, 2, Abstract, and Col. 5 ; lines 37-41 is misplaced since in none of these is any mention made of personal data meters 16, 17 and 18 being portable. In fact, they cannot be portable because then the fundamental feature of Kiefl's invention which relies on the use of remote control 10 would be rendered inoperable. The signal from remote control 10 might not reach a personal data meter if its position is not within the transmission area, i.e. in the vicinity of the TV receiver 15, reached by the remote control. If the Examiner remains of a different view, then he is requested to quote the exact wording in Kiefl on which he relies for this assertion.

The Examiner concedes (see the third paragraph on page 3 of the Office Action) that "Kiefl does not teach means for detecting a code signal that forms the broadcast signal in combination with a programming signal used to perform the program ...". However, the Examiner contends that this feature is disclosed by Weinblatt, and the Examiner then reaches the conclusion that:

> "It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the above audience monitoring feature of Weinblatt in the system of Kiefl as a an alternative means for achieving the predictable result of providing portable monitoring units that signals which

> indicate the television channel to which a person is tuned and the program to which said person is tuned."

Section 2143.01, subsection VI of the MPEP states that:

> If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.
>
> * * *
>
> The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate."

Kiefl's principle of operation relies on stationary personal data meters, a locally generated signal which is manually actuated by the audience member, and the use of a conventional broadcast signal. Weinblatt's principle of operation relies on portable monitoring units worn by the audience members, a signal which originates at the broadcasting station and is automatically reproduced locally with no intervention by the audience member, and the use of a significantly modified broadcast signal (i.e. one combined with a code signal for used for the audience monitoring).

Thus, Kiefl's principle of operation is clearly different from Weinblatt's principle of operation.

Moreover, it is respectfully submitted that the changes to Kiefl proposed by the Examiner to accommodate the features disclosed in Weinblatt require a substantial reconstruction and redesign of the elements shown in Kiefl. As such, the combination of Kiefl and Weinblatt cannot be supported.

In view of the factors presented above, the Examiner's rejection cannot stand.

Furthermore, Section 2143.01, subsection IV of the MPEP states that:

> A statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). **'''>[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'"

It is respectfully submitted that the Examiner has failed to satisfy the requirement for "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

Schroeder fails to bridge the gap between claim 1 and the combination of Kiefl and Weinblatt. There is nothing in Schroeder which even hints at the above-mentioned claimed features of the present invention that are missing in the other applied references.

In view of the foregoing, it is respectfully submitted that Kiefl, Weinblatt and Schroeder, whether taken alone or in combination, do not teach or suggest the subject matter recited in independent claim 1. Accordingly, claim 1 is patentable thereover under 35 U.S.C. §103(a).

Independent claim 2 is patentable over Kiefl, Weinblatt and Schroeder for reasons presented above with respect to claim 1.

Claims 3 and 4 are allowable over Kiefl in view of Weinblatt and Hansen under

Claim 3 includes the features discussed above with respect to claim 1 for distinguishing the invention over the combination of Kiefl, Weinblatt and Hansen. Hansen fails to bridge the gap between claim 3 and the combination of Kiefl and Weinblatt. There is nothing in

Hansen which even hints at the above-mentioned claimed features of the present invention that are missing in the other applied references.

In view of the foregoing, it is respectfully submitted that Kiefl, Weinblatt and Hansen, whether taken alone or in combination, do not teach or suggest the subject matter recited in independent claim. Accordingly, claim 3 is patentable thereover under 35 U.S.C. §103(a).

Independent claim 4 is patentable over Kiefl, Weinblatt and Hansen for reasons presented above with respect to claim 3.

Conclusion

In view of the foregoing, reconsideration and withdrawal of all rejections, and allowance of all pending claims is respectfully solicited.

Should the Examiner have any comments, questions, suggestions, or objections, the Examiner is respectfully requested to telephone the undersigned in order to facilitate reaching a resolution of any outstanding issues.

Respectfully submitted,

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